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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,704	09/12/2003	Minas Theodore Coroneo	Q77494	7676
23373	7590	03/06/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			GHERBI, SUZETTE JAIME J	
		ART UNIT	PAPER NUMBER	
			3738	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,704	CORONEO, MINAS THEODORE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Suzette J. Gherbi	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 February 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
  - 10) The drawing(s) filed on 28 January 2004 and 01 June 2005 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION**

1. Applicant's RCE dated 2/6/06 has been received in application serial number 10/660704. All comments have been taken into consideration.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular there is no support in the specification for "...the range of about..".

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "anteriorly" in claim 1 is a relative term which renders the claim indefinite. The term "anteriorly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In particular is not clear whether this "anterior" direction relates to a reflection or refraction.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 12-15, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Portney 2003/00199976. Portney discloses the structure of invention as claimed comprising: An IOL with an anterior and posterior surfaces [0024] defining a central visually transparent lens optic extending from the anterior to the posterior surface; and a peripheral portion outside the central lens optic, wherein the optical

properties of the peripheral portion are selected such that oblique incident light focusing (see [0044] which states that “*...several light rays obliquely incident on the intraocular lens optic and sowing the diverging of the light rays refracted by the optic through the transition zones surface...*” on the peripheral portion is diminished or refracted laterally or anteriorly as opposed to posteriorly; wherein the IOL is foldable; wherein the IOL has haptics and is used for the treatment of cataracts[0007]. See sections [0011; 0024-0027; 0030; **0044**; 0052; 0062-0063; 0065]).

9. The examiner points out that in claims 1 an “or” option is provided (...such that *oblique incident light focusing on said peripheral portion is diminished OR refracted laterally OR anteriorly as opposed to posteriorly*). Applicant seems to only argue one aspect of three choices in the claim. As admitted by applicant Portney discloses in claim 16 “....curvature shaped to minimize indirect glare created by a peripherally located source of light impinging through the optic on substantially width of said transition zone in an individual’s eye.” This meets the first of the three options given in the claim for that the oblique incident of light focusing on the peripheral portion is diminished. Further section [0052] describes the fact that “...the transition zone which is shaped for refraction incident light out of the transition zone in a manner minimizing indirect glare in the eye of individual in which the optic is implanted, also shown in broken lines is a projected peripheral edge...”

10. The intended use recitation/functional language of the claims carries no patentable weight in the absence of any distinguishing structure. Portney clearly

discloses the structure as claimed and is found to be inherently capable of performing the functions.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Brady et al. 2003/0144733. Portney has been disclosed above however Portney does not specify that the peripheral portion utilizes light absorbing material. Brady et al. teaches an IOL that features the use of light absorbing material/color (see [ 0123]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the invention of Portney and utilize the light absorbing materials/colors as taught by Brady et al. because both IOLS function is to reduce/diminish glare and both IOLS contain peripheral portions.

13. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Achatz et al. 4,813,955. Portney has been disclosed however

Portney does not specify that the oblique incident light is refracted on the peripheral portion forward the nasal retina in the eye. Achatz et al. teaches an IOL in which the incident is adjusted near the nasal portion (see col.2, lines 24-39. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lens of Portney such that the oblique incident light is directed forward of the nasal retina in the eye in order to divert it away from the retina into a location that is not effected.

***Allowable Subject Matter***

14. Claim 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claims 17 and 19 are allowed.

***Response to Arguments***

16. Applicant's arguments filed 2/6/05 have been fully considered but they are not persuasive. In response to applicant's arguments that the references (i.e. Portney) fail to show certain features of applicant's invention, it is noted that the features upon which

applicant relies/argues (i.e. fresnal lenses or that Portney has an inferior lens e.g.) are not recited in the rejected claim(s) and the arguments are not commensurate with the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. Applicant further alleges that Portney does not disclose "convexity" (which is not claimed) and does not suggest an explanation for photic disturbances in the temporal visual field.

18. The examiner has studied the "claims" as constructed. Portney does indeed address the limitations of "..configured to reduce or eliminate oblique incident light photic disturbances of the eye....wherein the optical properties of the peripheral portion are selected such that oblique incident light focusing on the peripheral portion is diminished or refracted laterally or anteriorly as opposed to posteriorly". Applicant is directed to see section [0044] figure 9 and [0093]. Figure 9 clearly illustrates that the light (whether parallel or not is not the issue) is impinging on an anterior surface at an angle and diverges in a lateral direction (112a).

19. Applicant believes that the 103 rejection of claims 5-7 of Portney and Brady is improper because "...*incident light is not absorbed or prevented from traveling posteriorly through the lens, rather, it is merely refracted over the pigmented peripheral edge of the lens..*" In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

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claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case The examiner has utilized the Brady reference not for the functionality i.e. the focusing mechanisms of the lens but to teach that absorbing materials have been utilized in the IOL art and are not a novelty. The motivation is derived from the fact that Portney's object is to reduce glare and light absorbing materials have been known to help to reduce glare.

20 Further applicant argues the combination of claims 8 and 19 of Portney in view of Achatz et al. and states that it is not obvious to combine the references. Once again as stated above the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The motivation for these claims is derived from the fact that both Portney and Achatz et al. teaches IOL's with segmented zones. By providing a zone closer to the wear's nose as taught by Achatz et al. and the curvatures as taught by Portney it is possible to refract oblique incidents of light to the forward portion of the nasal retina in the eye

21. It has also bee observed by the examiner that while applicant has provided product claims they mainly argue the functionality of the device. The office action above

is deemed proper because it teaches the structure as claimed and is capable of performing the functions as claimed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ***Paul et al. 6,468,306 ; Woffinden et al. 5,693,093 ; and Brady et al. 6,884,262 all read upon the subject matter as currently claimed.***

This is a continuation of applicant's earlier Application No. 10/660,704. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4751.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Suzette J-J Gherbi  
02 March 2006